

Objection of the Disclosure

The disclosure was objected to because the use of the term “single.” Applicant respectfully traverses the assertion and directs attention to Page 9, Line 24 of the subject application which indicates the tape may be comprised of a single layer or multi-layers. Withdrawal of the objection is respectfully requested.

§112 Rejection of the Claims

Claims 38-39 and 44 (and claims dependent therefrom) and claim 63 were rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Claim 38

Applicant respectfully traverses the rejection of claim 38. The term “adhesive layer” in line 4 creates antecedent basis for its use in lines 5 and 6.

Claims 39 and 44

Applicant has amended claims 39 and 44 to include the term “thermosetting” as suggested in the Office Action. The claim was not amended to avoid cited art. Applicant respectfully traverses the assertion that “pressure sensitive” is inaccurate. Attention is directed to page 10 of the subject application which indicates that adhesive layers may be responsive to heat, pressure, or both.

Reconsideration and withdrawal of the rejections are respectfully requested.

§102 Rejection of the Claims

Claims 34, 37-38 and 51-63 were rejected under 35 USC § 102(e) and (b), respectively, as being anticipated by or, in the alternative, under 35 USC § 103(a) as obvious over either King or Bradley.

Applicant respectfully traverses the rejections. “For a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a

single reference.” (emphasis added). *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990). To establish a *prima facie* case of obviousness, a prior art reference must teach **all** of the claim limitations. (Emphasis added). MPEP § 2143, *In re Royka*, 490 F.2d 981 (CCPA 1974). Applicant respectfully traverses the rejections under 35 U.S.C. §102 and 35 U.S.C. §103 since the cited art fails to establish all of the elements of the claims. For instance, Applicant cannot find in King or Bradley, *inter alia*, affixing a face of a semiconductor die to a second side of the adhesive tape as recited in claim 34. In addition, Applicant cannot find in King or Bradley, among other things, affixing a face of a semiconductor die to a second side of the adhesive tape as recited in claim 37. In addition, Applicant cannot find in King or Bradley, among other things, affixing a face of the semiconductor die to a second side of the adhesive tape as recited in claim 38.

Applicant notes that the Office Action disregards express limitations of claims 34, 37, 38, 51 - 63, and Applicant submits that the claims are not being examined by all of the claim language including all of the express limitations. The combination of elements in these claims, among others, have not been established as being taught by the prior art. By not examining the claims based on the claim language and ignoring express claim limitations, Applicant respectfully submits that the Office Action is distilling the invention down to a “gist” and ignores the requirement of analyzing the subject matter “as a whole.” See MPEP 2141.02; *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984); *Bausch & Lomb v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443, 447-49, 230 USPQ 416, 419-20 (Fed. Cir. 1986), *cert. denied*, 484 U.S. 823 (1987) (District court focused on the “concept of forming ridgeless depressions having smooth rounded edges using a laser beam to vaporize the material,” but “disregarded express limitations that the product be an ophthalmic lens formed of a transparent cross-linked polymer and that the laser marks be surrounded by a smooth surface of unsublimated polymer.”)

In the event the Office Action deems these missing elements from the art as, according to the Examiner, “being held NOT to constitute patentable differences,” Applicant traverses the assertion. Unless relying on impermissible hindsight reconstruction, the Office Action appears to be taking Official Notice of facts not specifically supported by the Patent and apparently

considers such as “well known” or common within the art. Applicant traverses the Official Notice and respectfully requests a patent under MPEP § 2144.03 to support the assertion, or in the alternative, withdrawal of this assertion from the rejection.

Applicant respectfully submits that King and Bradley relate to surface mount components, which have substantially different processing requirements than those of semiconductor die, and therefore would not anticipate nor render obvious the claims of the subject application. Applicant submits the cited references fail to anticipate or render obvious the claims as a whole. Reconsideration and allowance of claims 34, 37, 38, 51 - 63 is respectfully requested.

Claims 35-36 were rejected under 35 USC § 102(b) as anticipated by or, in the alternative, under 35 USC § 103(a) as obvious over Tsukahara. Applicant respectfully traverses the rejection. Applicant submits that the Office Action fails to establish a *prima case* of obviousness (or anticipation) since the cited reference fails to establish all of the elements of the claims. For instance, Applicant cannot find in the cited reference, and the Office Action fails to point out where it can be found, affixing a first side of tape including a first material of high glass transition temperature and a second material of low glass transition temperature, as recited in claim 35. Furthermore, Applicant cannot find in the cited reference, and the Office Action fails to point out where it can be found, affixing a first side of tape including a hybrid material having a thermoset component with a glass transition temperature of approximately 30 degrees C, as recited in claim 36.

Applicant notes that the Office Action disregards express limitations of claims 35 and 36, and Applicant submits that the claims are not being examined by all of the claim language including all of the express limitations. The combination of elements in these claims, among others, have not been established as being taught by the prior art. By not examining the claims based on the claim language and ignoring express claim limitations, Applicant respectfully submits that the Office Action is distilling the invention down to a “gist” and ignores the requirement of analyzing the subject matter “as a whole.” See MPEP 2141.02.

In the event the Office Action deems these missing elements from the art as, according to the Examiner, “being held NOT to constitute patentable differences,” Applicant traverses the assertion. Unless relying on impermissible hindsight reconstruction, the Office Action appears to be taking Official Notice of facts not specifically supported by the Patent and apparently considers such as “well known” or common within the art. Applicant traverses the Official Notice and respectfully requests a patent under MPEP § 2144.03 to support the assertion, or in the alternative, withdrawal of this assertion from the rejection.

Applicant respectfully requests reconsideration and allowance of claims 35 and 36.

Claim 39 was rejected under 35 USC § 102(b) and (e), respectively, as anticipated by or, in the alternative, under 35 USC § 103(a) as obvious over Baker et al. or Kotato et al. Applicant respectfully traverses the rejection. Applicant submits that the Office Action fails to establish a *prima case* of obviousness (or anticipation) since the cited reference fails to establish all of the elements of the claim. For instance, Applicant cannot find in the cited reference, and the Office Action fails to point out where it can be found, elevating the temperature to 100 degrees C, as recited in claim 39. Furthermore, Applicant cannot find in Baker, and the Office Action fails to point out where it can be found, affixing a face of a semiconductor die to a second side of adhesive tape, as recited in claim 39. Additionally, Applicant cannot find in Kotato affixing a first side of tape to a surface of an organic support structure, as recited in claim 39. Applicant further notes that the Office Action fails to establish or cite any motivation to combine the references.

Applicant notes that the Office Action disregards express limitations of claim 39, and Applicant submits that the claim is not being examined by all of the claim language including all of the express limitations. The combination of elements in this claim, have not been established as being taught by the prior art. By not examining the claims based on the claim language and ignoring express claim limitations, Applicant respectfully submits that the Office Action is distilling the invention down to a “gist” and ignores the requirement of analyzing the subject matter “as a whole.” See MPEP 2141.02.

In the event the Office Action deems these missing elements from the art as, according to the Examiner, "being held NOT to constitute patentable differences," Applicant traverses the assertion. Unless relying on impermissible hindsight reconstruction, the Office Action appears to be taking Official Notice of facts not specifically supported by the Patent and apparently considers such as "well known" or common within the art. Applicant traverses the Official Notice and respectfully requests a patent under MPEP § 2144.03 to support the assertion, or in the alternative, withdrawal of this assertion from the rejection.

Applicant respectfully requests reconsideration and allowance of claim 39.

§103 Rejection of the Claims

Claims 40-50 were rejected under 35 USC § 103(a) as being unpatentable over either Baker et al. or Kotato et al. Applicant respectfully traverses the rejection. Applicant submits that the Office Action fails to establish a *prima case* of obviousness since the cited reference fails to establish all of the elements of the claims.

Claims 40 - 43

Applicant submits that the Office Action fails to establish a *prima case* of obviousness since the cited reference fails to establish all of the elements of the claim. For instance, Applicant cannot find in the cited reference, and the Office Action fails to point out where it can be found, elevating the temperature to 100 degrees C, as recited in claim 39, from which claims 40 - 43 depend. Furthermore, Applicant cannot find in Baker, and the Office Action fails to point out where it can be found, affixing a face of a semiconductor die to a second side of adhesive tape, as recited in claim 39, from which claims 40 - 43 depend. Additionally, Applicant cannot find in Kotato affixing a first side of tape to a surface of an organic support structure, as recited in claim 39, from which claims 40 - 43 depend. Applicant further notes that the Office Action fails to establish or cite any motivation to combine the references.

In the event the Office Action deems these missing elements from the art as, according to the Examiner, "being held NOT to constitute patentable differences," Applicant traverses the assertion. Unless relying on impermissible hindsight reconstruction, the Office Action appears to be taking Official Notice of facts not specifically supported by the Patent and apparently

considers such as “well known” or common within the art. Applicant traverses the Official Notice and respectfully requests a patent under MPEP § 2144.03 to support the assertion, or in the alternative, withdrawal of this assertion from the rejection.

Applicant respectfully requests reconsideration and allowance of claims 40 - 43.

Claims 44 - 50

Applicant submits that the Office Action fails to establish a *prima case* of obviousness since the cited reference fails to establish all of the elements of the claim. For instance, Applicant cannot find in the cited reference, and the Office Action fails to point out where it can be found, elevating the temperature and applying pressure to tape for 100ms, as recited in claim 44, from which claims 46 - 50 depend. Furthermore, Applicant cannot find in Baker, and the Office Action fails to point out where it can be found, affixing a face of a semiconductor die to a second side of adhesive tape, as recited in claim 44, from which claims 46 - 50 depend. Additionally, Applicant cannot find in Kotato affixing a first side of tape to a surface of an organic support structure, as recited in claim 44, from which claims 46 - 50 depend. Applicant further notes that the Office Action fails to establish or cite any motivation to combine the references.

In the event the Office Action deems these missing elements from the art as, according to the Examiner, “being held NOT to constitute patentable differences,” Applicant traverses the assertion. Unless relying on impermissible hindsight reconstruction, the Office Action appears to be taking Official Notice of facts not specifically supported by the Patent and apparently considers such as “well known” or common within the art. Applicant traverses the Official Notice and respectfully requests a patent under MPEP § 2144.03 to support the assertion, or in the alternative, withdrawal of this assertion from the rejection.

Applicant respectfully requests reconsideration and allowance of claims 40 - 50.

Comments of Paragraph 1

Applicant respectfully traverses the assertion that the continuing data information is inappropriate or improper. Applicant respectfully submits that MPEP §608.01(p) does not limit incorporation by reference to only issued or allowed patents. Withdrawal of the assertion is respectfully requested.

Comments of Paragraph 8

Applicant respectfully submits that paragraph 8 has insufficient detail in order to prepare a response thereto. For example, it is unclear as to which elements the Examiner considers essential. Furthermore, regarding the statement “any differences which might possibly exist between the envisioned, claimed inventions and the teachings of these respective references being held NOT to constitute patentable differences,” Applicant requests clarification as to which differences the Office Action is referring to, and a basis on which the Office Action relies to make such a statement. In any event, Applicant respectfully submits that a *prima facie* case has not been established by the Office Action since all elements of the claims have not been established. Applicant respectfully requests clarification or removal of the assertions of paragraph 8, and reserves the right to further respond to the assertions made in paragraph 8.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612- 359-3276) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Commissioner of Patents, Washington, D.C. 20231, on this 17th day of October, 2001.

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